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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,583	02/24/2004	Cheung Chong Kao	14518/0001	9901
7590	01/13/2006			EXAMINER MAY, ROBERT J
G. Brian Pingel Brown, Wincik, Graves Regency West 5, Ste. 277 4500 Westown Parkway West Des Moines, IA 50266			ART UNIT 2875	PAPER NUMBER
DATE MAILED: 01/13/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/785,583	KAO, CHEUNG CHONG
	Examiner Robert May	Art Unit 2875

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 28 October 2005.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 2 and 16 is/are withdrawn from consideration.
- 5) Claim(s) 15 and 17 is/are allowed.
- 6) Claim(s) 1-5, 8-10 and 12-14 is/are rejected.
- 7) Claim(s) 6-7 and 11 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All
  - b) Some \*
  - c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

### ***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The term slot as recited in Claim 9 has no antecedent basis in the specification.

### ***Claim Objections***

Claim 3 incorrectly depends from Claim 2, which is cancelled. The office will construe this claim as depending from Claim 1.

Appropriate Correction is required.

### ***Response to Arguments***

Applicant's arguments regarding Claims 1 & 10 filed on the 28 October 2005 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., trunk) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding Claims 1 & 10, the examiner disagrees with the applicant's assertion that Puelo teaches away from securing any fiber bundles to the base passing them through the trunk. Puelo clearly discloses a trunk 16, which comprises an optical bundle.

Applicant's other arguments with respect to claims to amended Claim 1 & original Claim 10 have been considered but are moot in view of the new ground(s) of rejection.

Regarding Claim 3, the examiner disagrees with the applicant's assertion that neither Puelo nor Oster disperse optic fibers among the branches as recited in Claim 3. Puelo clearly discloses in Figure 3, the fiber optic ends 56 as being dispersed among the branches in light of the fact that they are shown as being at the end of the branches.

Regarding Claims 4 & 12, the examiner disagrees with the applicant's assertion that none of the cited prior art discloses an adaptor for into which the trunk fits into. Puelo clearly discloses an adaptor or slot 24 into which the trunk 16 slides.

Regarding Claims 8-9 & 14 the Examiner disagrees with the assertion that Ferguson teaches away from placing vent holes in the heat-generating base of Puelo. Simply because the base in Ferguson is at the bottom of the tree does not make the combination of vent holes with the base of Puelo novel because any housing with a motor and light source generates heat and it is well known in the art use vent holes. Furthermore, the applicant asserts that the heat-generating portion is along the trunk, but the examiner sees no disclosure of this in the reference especially when referring to the column and section as referenced by the applicant.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Amended Claims 1, 3-5, 10, & 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Puelo in view of Oster as cited in the previous office action and further in view of Wang (US Pat 6,039,453).

Regarding Claim 1, 4,10, & 12, Puelo discloses in Figure 3, a plurality of optical fibers in the bottom section of the tree 54 and top section of the tree 22 (Col 7, lines 41-43) that have a first end 23 and a second end 56, a base structure comprising a housing 26, more than one light source 38, motor 37 with spindle, and light governing disc 36, a bundle assembly comprising a cover or top plate 32, and a plurality of bundles of optical strands 54 that form a plurality of tree like branches that fit into spaced apart apertures 40 in the cover wherein each bundle receives light from each of the plurality of bulbs 38 (Col 7, Lines 45-47). Furthermore, Puelo discloses a means for securing the ends of

the fiber optics forming bundles comprising a rigid wire member 42 or sleeve, which encases and secures the optic fibers 54. However,

Regarding Claims 1, & 10, Puleo does not disclose a light governing disc with two concentric tracks comprising a first track including successive transparent color bars, and a second track including alternating monochromatic dark and light bars where as the motor turns each track travels between the fiber optic bundle 54 and the lamp 38.

Regarding Claims 1 & 10, Oster discloses in Figures 5 and 6 a turntable which rotates between the light sourced and the fiber optic trunk base of a lighting system wherein the turntable is divided into two sections of arc like bands that are each of a different color and each section is concentric with respect to each other as disclosed in Figures 5 and 6. The two sections of the turntable allow each light source to follow an assigned track or concentric section of the turntable so as to have a particular color sequence or scheme assigned to each fiber bundle. Therefore, it would be obvious to one of ordinary skill in the art to modify the teachings of Puleo by replacing the color wheel of with the turntable of Puleo in order to assign a particular color sequence or scheme to each fiber bundle of Puleo. However, Oster does not disclose either of the tracks of comprising monochromatic dark and light bars.

Regarding Claims 1 & 10, Wang discloses in Figures 3 - 5, a lighted water globe that has fiber optic strands 7 with a base comprising a lamp 15, and a wheel 18 which rotates and has an alternating opaque and transparent design that gives the visual effect that the fiber optic strands are blinking on and off (Col 4, Lines 6-11). Therefore, it would be obvious to modify the rotating disc of Puleo and Oster with the wheel of

Wang having an alternating opaque and transparent design to give the visual effect of blinking.

Regarding Claims 3 & 5, Puelo discloses in Figure 3, a trunk 16 comprising bundled fiber optic strands 22 that is associated with the cover 32 by inserting the trunk 16 into an opening or socket 24 as shown and having a plurality of branches where the ends of the optic strands 56 are dispersed among the branches 46.

Regarding Claim 13, Puelo discloses in Figure 3, each of the lamps 38 comprising a mounting bracket (not labeled) on which the lamps 38 reside, which are integral to the interior of the base structure or housing 26.

Claims 8-9, & 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Puelo in view of Oster as applied to claims 1 & 13 above, and further in view of Ferguson as cited in the previous office action.

Regarding Claims 8-9, & 14, Puelo in view of Oster and Wang does not disclose the base structure comprising venting means to allow heat generated to escape. However, Ferguson discloses in Figure 4 a vent hole 46 in the base of the fiber optic Christmas tree for allowing heat to escape from the base generated by the light source (Col 5, Lines 14-17). And it is generally obvious to one of ordinary skill interchange holes for slots for a venting means in order to position the slots in a desired manner. Therefore it would be generally obvious to one of ordinary skill in the art to modify the teachings of Puelo in view of Oster to have a vent hole or slot in the base of the fiber

optic lighting apparatus in order to allow the heat escape from the base generated by the light source and to position the slots in a desired manner.

***Allowable Subject Matter***

Claims 15 & 17 are allowed.

Claim 6-7, & 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is an examiner's statement of reasons for allowance:

Regarding Claims 6, 11, & 15, the prior art does not teach or suggest an apparatus as recited by Claims 4, 10 & 15 wherein the sleeve element comprises a closed and at least semi transparent end.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert May whose telephone number is (571) 272-5919. The examiner can normally be reached between 9 am– 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (571) 272-2378. The fax number for the organization where this application or proceeding is assigned is (571) 273-8300 for all communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval PAIR system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you

have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RM

1/6/2006



JOHN ANTHONY WAH  
PRIMARY EXAMINER